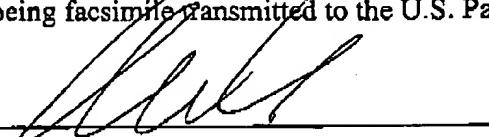


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CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that this paper is being facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

Date: 2/1/2005 Signature: 

From: Richard A. Neifeld Registration No.: 35,299
Name of Person Signing Certificate

Telephone Number: 703-415-0012

To: Examiner: Janvier

Group Art Unit: 3622

RE: U.S. Application Number/Patent Number: 09/756,788

Filed/Issued: 1/10/2001

Attorney Docket Number: CAT/29US-SCRC03

TOTAL NUMBER OF PAGES INCLUDING THIS PAGE: 19

Attached are the following documents:

Transmittal Letter and Authorization to Charge Deposit Account (in Duplicate)
37 CFR 1.144 Petition from Requirement of Restriction

COMMENTS

Please charge our deposit account \$130.00.

In the event that any additional fees are due, including any fees required under 37 CFR 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge the required fees to our Deposit Account No. 50-2106. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 CFR 1.136 for the necessary extension of time.

January 27, 2005 (6:18pm)

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**TRANSMITTAL LETTER AND
AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

RE: Attorney Docket No.: CAT/29US-SCRCO3
Application Serial No.: 09/756,788
Filed: 1/10/2001
Title: System and Method for Providing Shopping Aids and Incentives to
Customers Through a Computer Network
Inventor: SCROGGIE et al.
Group Art Unit: 3622
Examiner: JANVIER

SIR:

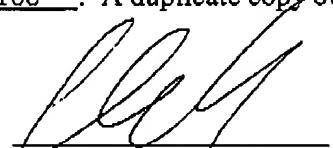
Attached hereto for filing are the following papers:

37 CFR 1.144 Petition from Requirement of Restriction

Please charge our account in the amount of \$130.00 to cover the required fees.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-2106. A duplicate copy of this sheet is enclosed.

2/1/2005
Date


Richard A. Neifeld, Ph.D.
Registration No. 35,299
Attorney of Record

Printed: January 26, 2005 (3:59pm)
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**TRANSMITTAL LETTER AND
AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

RE: Attorney Docket No.: CAT/29US-SCRC03
Application Serial No.: 09/756,788
Filed: 1/10/2001
Title: System and Method for Providing Shopping Aids and Incentives to
Customers Through a Computer Network
Inventor: SCROGGIE et al.
Group Art Unit: 3622
Examiner: JANVIER

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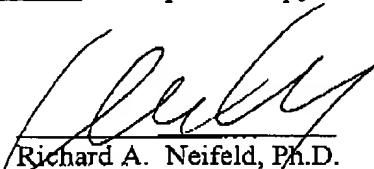
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37 CFR 1.144 Petition from Requirement of Restriction

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2/1/2005
Date


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Registration No. 35,299
Attorney of Record

Printed: January 26, 2005 (3:59pm)
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NEIFELD DOCKET NO: CAT/29US-SCRC03

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: SCROGGIE et al. CONF. NO: 6599

GROUP ART UNIT: 3622

SERIAL NO: 09/756,788

FILED: January 10, 2001

EXAMINER: JANVIER

FOR: System and Method for Providing Shopping Aids and Incentives to Customers
Through a Computer Network

37 CFR 1.144 PETITION FROM REQUIREMENT OF RESTRICTION

ASSISTANT COMMISSIONER FOR PATENTS

WASHINGTON, D.C. 20231

I. Statement of the Precise Relief Requested

The applicant requests that the Director (1) withdraw the restriction requirement and (2) have the examiner reinstate the supplemental appeal brief filed August 4, 2004.

II. Material Facts in Support of the Petition

FACT 1. On January 10, 2001, the applicant filed the subject application containing claims 32-58.

FACT 2. On January 21, 2003, the examiner mailed a non-final office action.

FACT 3. On April 17, 2003, the applicant filed a 37 CFR 1.111 amendment which added claims 59-91.

FACT 4. On September 17, 2003, the examiner mailed a final office action which acknowledged claims 32-91 (see page 2 of the office action, line 15), but examined claims 32-58.

FACT 5. On March 15, 2004, the applicant filed an appeal brief which contained no amendments.

FACT 6. On May 4, 2004, the examiner mailed a second final office action. The examiner stated at page 6 lines 13-14 of the office action that: "Applicant's amendment necessitated the new grounds of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL.**" The applicant did not enter an amendment with the appeal brief filed March 15, 2004.

FACT 7. On July 15, 2004, the applicant filed a petition to remove the final status because the office action mailed May 4, 2004 contained new grounds of rejections for claims 32-91 and withdrew all prior rejections; and the new grounds of rejection in the final office action mailed May 4, 2004 were not necessitated by any action on the part of the applicant.

FACT 8. On August 4, 2004, the applicant filed a supplemental appeal brief and request for reinstatement of the appeal. The supplemental appeal brief contained the identical claims as the claims filed April 17, 2003.

FACT 9. On August 27, 2004, the Director mailed a response granting the petition, thereby withdrawing the finality of the office action mailed May 4, 2004.

FACT 10. On October 29, 2004, the examiner mailed a non-final office action. The cover page of the office action dated October 29, 2004 indicates that claims 32-91 are subject to restriction.

FACT 11. The cover page of the office action dated October 29, 2004 states that:

In the office action mailed October 29, 2004, the examiner stated that:

1. Restriction to one of the following inventions is required under 35 USC 121:
 - I. Claims 32-56 and 59-91, drawn to a method of and system for delivering incentives over the Internet comprising a Web site for providing purchasing incentives from multiple sources, a consumer purchase history database based on consumer online shopping activity, a consumer database, which can identify consumers by their e-mail addresses, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site and means for delivering purchasing incentives to consumers by e-mail.
 - II. Claim 57, drawn to a method of and system for providing, via a Web site, purchasing incentives from multiple sources such as retailers and manufacturers comprising a personal database, a consumer purchase history database based on consumer online shopping activity, **means for generating a web page with a consumer-specific display and means for updating said web page.**

III. Claim 58, drawn to a method for delivery of incentives by e-mail, comprising the steps of maintaining a consumer database, which identifies consumers by their e-mail addresses, generating targeted purchase incentives from a consumer purchase history database and **formatting an e-mail message to a consumer by electronic mail for subsequent printing of a coupon** and delivering said e-mail to the consumer.

The inventions are distinct, each from the other because of the following reasons:

For example, Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed. The subcombination has separate utility by itself such as **means for generating a web page with a consumer-specific display and means for updating said web page**.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

[Office action mailed October 29, 2004 page 2 line 18 through page 4 line 13.]

FACT 12. On January 28, 2005, the applicant filed a response traversing the requirement, with a provisional election of Group I.

FACT 13. In the response filed on January 28, 2005, the applicant stated that:

II. Provisional Election with Traverse

In response, the applicant provisionally elects group I, claims 32-56

and 59-91 with traverse. The applicant traverse the requirement because the requirement does not comply with authority binding upon the examiner for the many reasons noted below.

The MPEP is binding upon the examiner insofar as it is the procedural requirements imposed on the examiner by the Director. Therefore, a restriction requirement that fails to comply with the MPEP is improper and should be withdrawn. Cf. In re Portola, 110 F.2d 786, 788, 42 USPQ2d 1295, ___ (Fed. Cir. 1997).

III. The Restriction Requirement is After Final Action

MPEP 802 Basis for Practice in Statute and Rules states in pertinent part that:

37 CFR 1.142 Requirement for restriction.

(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action.

[Emphasis supplied.]

The plain meaning of the emphasized portion of 37 CFR 1.142 cited above is that a request for restriction cannot be made after final action. The passage "Such requirement will normally be made before any action on the merits;" indicates the normal course of action. The passage "however, it may be made at any time before final action" is a catch-all description for the timing of a restriction requirement. MPEP 802 Basis for Practice in Statute and Rules makes no provision for a restriction requirement after final action.

Moreover, MPEP 818.03(a) Reply Must Be Complete, quoting 37 CFR

1.111(b) states in pertinent part that:

The applicant's or patent owner's reply must appear throughout to be a *bona fide* attempt to advance the application or the reexamination proceeding to final action. . . .

By stating that an applicant's reply to a restriction requirement must advance the proceeding to final action, MPEP 818.03(a) indicates that a restriction requirement must be made before final action.

The subject restriction requirement was imposed after a second final action mailed May 4, 2004, after a first final action mailed September 17, 2003, after a first appeal brief in response to the first final action mailed September 17, 2003, and after request to reinstate the appeal and second appeal brief in response to the second final action mailed May 4, 2004. Therefore, a restriction requirement, which was made after final action, is improper and should be withdrawn.

IV. No Burden on Examiner for a Search and Examination of an Entire Application

A. The Restriction Requirement Fails to Comply with MPEP 803

1. MPEP 803 Restriction - When Proper

MPEP 803 states the burden on the examiner for a search and examination of an entire application:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

The applicant points out that the examiner has not shown that examining invention groups I, II, and III, in this application imposes a serious examination burden.

Given the erroneous analysis as to combination/subcombination and the scope of claimed subject matter, and the absence of separate classifications, the election requirement is improper and should be withdrawn.

Given that the examiner has been working on all claims in this

application and the application has twice been finally rejected, there appears to be no possibility of any significant burden in continued examination, particularly after appeal.

2. MPEP 803 Guidelines

In its Guidelines section, MPEP 803 states that:

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP 808.02.

MPEP 808.02 states that:

Where the related inventions as claimed are shown to be distinct under the criteria of MPEP 806.05(c) - 806.05(i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

(A) **Separate classification thereof:** This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) **A separate status in the art when they are classifiable together:** Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) A different field of search: Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.

The examiner has concluded that the inventions are distinct, stating in the office action mailed October 29, 2004 on page 4 lines 7-13:

... In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed. The subcombination has separate utility by itself such as **means for generating a web page with a consumer-specific display and means for updating said web page.**

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art and required a separate search and hence, restriction for examination purposes as indicated is proper.

The examiner has not met the serious burden for purposes of the initial requirement, of showing by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP 808.02. Therefore, the applicants assert that the restriction requirement is improper and should be withdrawn.

B. The Restriction Requirement Runs Counter to MPEP 706.07

MPEP 706.07 states the conditions precedent to final rejection or action. MPEP 706.07 states in pertinent part that:

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be **thoroughly searched in the first action** and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection.

[Emphasis supplied.]

* * *

While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," **present practice does not sanction hasty and ill-considered final rejections.** [Emphasis supplied.]

* * *

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be **clearly developed** to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection. [Emphasis supplied.]

The three passages above from MPEP 706.07 reinforce the assertion that a thorough search and examination of an entire application **must be** performed prior to final action. Since the examiner is required to perform a thorough search and examination of an entire application prior to final action,

the search and examination has already been performed and there is no serious burden on the examiner for a search and examination of an entire application after final action as specified above by MPEP 803. Therefore, the restriction requirement is improper and should be withdrawn.

C. The Restriction Requirement Runs Counter to MPEP 811

MPEP 811 dictates the time for making a requirement for restriction, stating in pertinent part that:

Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required.

The examiner has not justified that there is a serious burden if restriction is not required. The examiner's assertion that a separate search is required is untenable, since according to MPEP 706.07 (cited above), a complete search must be performed prior to issuing a final action.

Since the examiner has not shown a serious burden if restriction is not required, the election requirement is improper and should be withdrawn.

V. The Restriction Requirement Fails to Comply with MPEP 816

MPEP 816 states that:

816 Give Reasons for Holding of Independence or Distinctness

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

For example, relative to combination and a sub-combination thereof, the examiner should point out the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or she

considers that the combination as claimed does not rely on the subcombination as its essential distinguishing part.

Each other relationship of claimed invention should be similarly treated and the reasons for the conclusions of distinctness of invention as claimed set forth.

The separate inventions should be identified by a grouping of the claims with a short description of the total extent of the invention claimed in each group, specifying the type or relationship of each group as by stating the group is drawn

to a process, or to subcombination, or to product, etc., and should indicate the classification or separate status of each group, as for example, by class and subclass. See MPEP § 809.

The applicant points out that, with respect to the group I claims, the examiner has not pointed out "the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or she considers that the combination as claimed does not rely on the subcombination as its essential distinguishing part."

Specifically, the examiner provides no rationale for why the combination as claimed does not require the particulars of the subcombination as claimed [Office action mailed October 29, 2004 page 4 lines 7-8.] Therefore, there is no support for the factual predicate upon which the examiner bases the restriction analysis.

Moreover, the examiner has not classified the groups of the alleged three inventions, as specified in MPEP 816.

Furthermore, the examiner has not provided reasoning with respect to Invention I and Invention II, Invention I and Invention III, and Invention II and Invention III indicating why the examiner believes these inventions are legally distinct.

Therefore, for all the foregoing reasons, the restriction requirement is improper and should be withdrawn.

VI. The Restriction Requirement Fails to Comply with MPEP 817

MPEP 817 states that:

817 Outline of Letter for Restriction Requirement Between Distinct Inventions

The statement in MPEP § 809.02 through § 809.02(d) is adequate indication of the form of letter when election of species is required.

No outline of a letter is given for other types of independent inventions since they rarely occur.

The following outline of a letter for a requirement to restrict is intended to cover every type of original restriction requirement between related inventions including those having linking claims.

OUTLINE OF LETTER

(A) Statement of the requirement to restrict and that it is being made under 35 U.S.C. 121

(1) Identify each group by Roman numeral.

(2) List claims in each group. Check accuracy of numbering of the claims; look for same claims in two groups; and look for omitted claims.

(3) Give short description of total extent of the subject matter claimed in each group, pointing out critical claims of different scope and identifying whether the claims are directed to a combination, sub-combination, process, apparatus, or product.

(4) Classify each group.

The examiner has not given a "short description of total extent of the subject matter claimed in each group, pointing out critical claims of different scope and identifying whether the claims are directed to a combination, sub-combination, process, apparatus, or product," as required by MPEP 817.

Additionally, the examiner has not classified the groups of the alleged three inventions, as specified in MPEP 817(4).

Moreover, the examiner has not shown that any of the three groups meet any criteria for restriction relative to the other group, as required by MPEP 817.

Therefore, the restriction requirement is improper and should be withdrawn.

VII. The Serious Burden Placed Upon the Applicants by the Requirement

The applicants request that the examiner keep in mind the serious (and often unnecessary) financial burden placed upon *the applicants* in having to split prosecution between division applications in response to restriction requirements, particularly at this late stage of prosecution. Given the applicant's reliance in filing two appeal briefs and the examiner's undue delay in asserting an office action necessitating a requirement for restriction, the applicants assert that the doctrines of equitable estoppel and laches apply. Accordingly, the applicants request that the examiner drop the restriction requirement, as being equitably improper under the doctrines of reliance estoppel and laches.

VIII. Closure

For all of the foregoing reasons, the election requirement is improper and should be withdrawn. Therefore, the examiner should withdraw the requirement and proceed to examine the application for compliance with all other statutory requirements.

Should Examiner Janvier have any questions, the examiner is urged to contact the undersigned at (703) 415-0012.

FACT 14. On January 28, 2005, along with the response to the restriction requirement, the applicant filed a second supplemental appeal brief and a second request for reinstatement of the appeal. However, the second supplemental appeal brief was limited to the claims the applicant provisionally elected.

FACT 15. This petition is filed after a request for reconsideration was filed, as specified in 37 CFR 1.144, last sentence.

III. Reasons Why the Relief Requested Should be Granted

The restriction requirement should be withdrawn because (1) the examiner has not shown it to be proper and (2) it is in fact improper. This application is after a second final rejection and two appeal briefs! At this point in prosecution, it is inequitable, improper, and arbitrary and capricious for the examiner to impose restriction, instead of an examiner's answer.

MPEP 802 states in pertinent part:

802 Basis for Practice in Statute and Rules

37 CFR 1.142 Requirement for restriction.

(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). **Such requirement will normally be made before any action on the merits;** however, it may be made at any time before final action.

[Emphasis supplied.]

The plain meaning of the emphasized portion of 37 CFR 1.142 cited above is that a request for restriction cannot be made after final action. The passage "Such requirement will normally be made before any action on the merits;" indicates the normal course of action. The passage "however, it may be made at any time before final action" is a catch-all description for the timing of a restriction requirement. MPEP 802 Basis for Practice in Statute and Rules makes no provision for a restriction requirement after final action.

Therefore, the restriction requirement, which was made after final action, is procedurally improper and arbitrary and capricious in nature, and should be withdrawn.

MPEP 803 states:

803 Restriction - When Proper

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

The applicant points out that the examiner has not shown that examining invention groups I, II, and III, in this application imposes a serious examination burden. Given the lack of analysis as to combination/subcombination and the scope of claimed subject matter, and the absence of separate classifications, the election requirement is improper and should be withdrawn.

Moreover, search and examination of the entire application already occurred, – twice! There is simply no reason that can reasonably be put forth how an application prosecuted to appeal twice already, with all claims fully examined and finally rejected, would present a "serious burden." All the examiner has to do is draft an answer!

MPEP 808 states:

808 Reasons for Insisting Upon Restriction

Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why the inventions as claimed are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween as set forth in the following sections.

Regardless of whether claimed inventions are "independent and distinct" as required by 35 USC 121, the Director requires there to be "reasons for insisting upon restriction therebetween as set forth in the following sections." The only reason presented in the office action to restrict is (office action page 4 lines 8-10) "The subcombination has separate utility

by itself such as **means for generating a web page with a consumer-specific display and means for updating said web page.**"

The examiner provides no facts supporting his conclusion that "The subcombination has separate utility by itself such as **means for generating a web page with a consumer-specific display and means for updating said web page.**" The examiner provides no basis for "reasons for insisting upon restriction". Moreover, in the office action, the examiner does not classify Inventions I, II, and III.

For the foregoing reasons, the examiner has not established any burden in examining Inventions I, II, and III, and therefore has not established "the reasons for insisting upon restriction" as required by MPEP 808. Therefore, the restriction is improper and should be withdrawn.

The Serious Burden Placed Upon the Applicants by the Requirement

The applicant requests that the Director keep in mind the serious (and often unnecessary) financial burden placed upon *the applicant* in having to split prosecution between division applications in response to restriction requirements, and the loss of patent term, particularly at this late stage of prosecution. Given the applicant's reliance in filing three appeal briefs, two petitions, and a response to a requirement for restriction; and the examiner's undue delay in asserting an office action necessitating a requirement for restriction (the claims which were the subject of the restriction requirement have been the same since April 17, 2003), the applicants assert that the doctrines of equitable estoppel and laches apply. Accordingly, the applicants submit that the Director should withdraw the restriction requirement, as being equitably improper under the doctrines of reliance estoppel and laches.

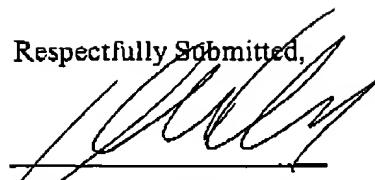
IV. Conclusion

Assuming the Director agrees that the restriction requirement is improper, the Director should reinstate the appeal brief filed August 4, 2004, since that brief addresses all pending claims, as opposed to the brief filed January 28, 2005.

2/1/2005

Date

Respectfully Submitted,


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Printed: February 1, 2005 (1:20pm)

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